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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,578	01/23/2001	Ilya Trakht	55099-B/JPW/KRD	2749

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EXAMINER

SCHWADRON, RONALD B

ART UNIT	PAPER NUMBER
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1644

DATE MAILED: 10/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/767,578

Applicant(s)

TRAKHT, ILYA

Examiner

Ron Schwadron, Ph.D.

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 29-33 is/are rejected.
- 7) ☒ Claim(s) 34 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/19/2005 has been entered.

2. The rejection of claims 29-33 under 35 U.S.C. 103(a) as being unpatentable over Oestberg et al. (US Patent 4,634,664) in view of Gustafsson et al. and Carroll et al. for the reasons elaborated in the previous Office Action are withdrawn in view of the amended claims.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 29-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no support in the specification as originally filed for the recitation of "human antibody nonproducing myeloma cell" or "mouse antibody nonproducing myeloma cell" in claim 29 or 30. Regarding applicants comments about the specification, page 29, the cited passages of the specification are drawn to use of myeloma cell lines to produce *B6B11* or *B6B11-like cells* (*B6B11* cells were made from a fusion of HAT-sensitive and G-418 resistant myeloma X63.Ag8.653 cells and subclone of human myeloma RPMI 8226 selected for non secretion of lambda light

chains). The aforementioned passages do not disclose the production of other heteromyeloma cell lines and therefore the disclosure is not of the scope of the instant limitation which encompasses use of myeloma cell lines to produce heteromyeloma cells other than B6B11 or B6B11 like cells. In addition, the cited passages do not disclose that the aforementioned cell lines are "antibody-nonproducing". The disclosure indicates use of mouse myeloma cells without stating that the mouse myeloma cells are antibody-nonproducing. Furthermore, the specification does not indicate that the human myeloma cells used are "antibody-nonproducing", it discloses that they are selected for "non-secretion of antibody". The quoted passage of the specification is silent as to whether the particular myeloma X63.Ag8.653 cell line used does or doesn't produce antibody. Regarding the RPMI 8226 cell line referred to in the specification, the specification discloses that said cell line does not secrete lambda light chains, not that the cell line does not secrete antibody. Said disclosure differs in scope from the limitation "antibody-nonproducing" because "antibody nonproducing" encompasses a variety of potential mechanisms wherein the antibody is not produced (doesn't produce heavy chain or lacks the ability to assemble and secrete antibody) wherein the scope of said limitation is broader than the disclosure in the specification that the human myeloma does not secrete lambda light chain. It is also does not encompass human myeloma cells that do not produce antibody because they do not produce kappa light chain. The cited passages of the specification, page 37-38 disclose experimental procedures used to produce the B6B11 cell line. The specification page 35 similarly refers to B6B11 hybrid cells.

There is no support in the specification as originally filed for the scope of the claimed invention (aka the claimed invention constitutes new matter).


5. Claim 34 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ron Schwadron, Ph.D. whose telephone number is 571 272-0851. The examiner can normally be reached Monday to Thursday from 7:30am to

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6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan, can be reached at 571 272 0841. The fax phone number for the organization where this application or proceeding is assigned is 703-

872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


RONALD B. SCHWADRON
PRIMARY EXAMINER
GROUP 1800-1600

Ron Schwadron, Ph.D.

Primary Examiner

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